

No. 15132

IN THE

# United States Court of Appeals

FOR THE NINTH CIRCUIT

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MUENCH-KREUZER CANDLE CO., INC., a corporation,  
*Appellant,*

*vs.*

LESTER F. WILSON,  
*Appellee.*

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## APPELLEE'S BRIEF.

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H. CALVIN WHITE,  
611 Wilshire Boulevard,  
Los Angeles 17, California,  
*Attorney for Appellee.*

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**APPELLEE'S BRIEF.**

---

This action was brought by Lester F. Wilson the inventor and undisputed owner of patent 2,464,361, against Muench-Kreuzer Candle Co., a New York corporation, for infringement of the patent. Appellant-Defendant alleged invalidity of the patent, admitted infringement by certain of its earlier candles, denied infringement by certain of its later candles, and "reserved" for consideration of the Court the alleged absence of a necessary or indispensable party.

The District Court afforded both parties full and complete hearing on the evidence and arguments, and as the record will show, observed and examined with such thoroughness the various exhibits presented by appellant, that there can be no question concerning Judge Hall's complete familiarity with the facts and his ability

to evaluate their significance in this action. Exhibits were produced and testimony given by appellant's sole witness Norbert C. H. Muench, Vice-President of appellant, and by appellee Lester F. Wilson and Ira C. Bechtold, chemist and chemical engineer.

### The Wilson Patent.

The Wilson invention will be readily understood from the patent itself [R. 328-330].\* Though simple, the invention represents originality and ingenuity of a high order, a fact not only self-evident from seeing the candle itself, but apparent also by comparison with all the evidence developed and presented in this suit.

Application for the Wilson patent was filed March 13, 1945 on an invention distinctly characterized by certain novel structural and performance features which appellant has been completely unable to find in the prior art, and which should be kept in mind in appraising the merits of its appeal.

1. A candle purposely made to drip profusely;
2. Having *concealed* within its interior a *longitudinal succession of different wax coloring materials* or dyes initially undissolved in the wax bulk or body of the candle, so that;
3. Upon burning of the candle the dyes will dissolve or disperse in the body wax and color the drippings successively *different and unpredictable colors*; and
4. Out of a *single* candle will be produced a decorative accumulation of variegated drippings.

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\*Like references are made throughout this brief to page numbers of the printed "Transcript of Record."

In the Patent Office prosecution of the Wilson application, the Examiner erroneously rejected the claims on prior patents the same or similar to many of the publications relied upon by defendant. The Board of Appeals reversed the Examiner in holding:

“We do not find, however, any suggestion in the prior art of the treatment of candles in any way which would produce a result disclosed by applicant. In view of the conclusion that the subject matter is useful and of sufficient importance and that the claims define a structure which is not anticipated by the prior art, it should be regarded as involving the element of invention, notwithstanding the simplicity of the inventive thought when once arrived at and what appellant has done. Judged by any standards announced by the courts it is entitled to patent protection.”

Thus did the Board of Appeals, acting pursuant to the Constitutional intent that the useful arts and sciences shall be encouraged by patent grants, sanction the issuance of the Wilson patent. That the public has benefited by the invention is shown by Wilson's sales of his candles [Pltf. Ex. 4] starting in 1945 and as compiled through 1955 [Pltf. Ex. 15; R. 56, 338]. Included in the public that has benefited, or has sought to benefit from the invention, are certain admitted infringers, including appellant, who have failed completely to show any prior knowledge by them, or others, of the Wilson invention prior to issuance of the patent, but who for no apparent reason other than determination to override a small manufacturer, have taken the invention for their own gains.

Here is what happened in two instances related in the Record. The Wilson patent issued March 15, 1949.

As related by Mr. Wilson [R. 58-64], Victrylite Candle Company, of Wisconsin, commenced infringement of the patent. Wilson filed suit December 5, 1949 (Civil Action 4904) for infringement in the United States District Court for the Eastern District of Wisconsin, a certified copy of the complaint being Plaintiff's Exhibit 7. Victrylite Candle Company answered [Pltf. Ex. 8], pleading, it will be noted, about the same prior art relied upon by defendant herein. Consent decree [Pltf. Ex. 9] was entered against Victrylite Candle Company, after Victrylite requested and was granted certain license rights [Pltf. Ex. 5; R. 331], under which royalties have been paid according to Plaintiff's Exhibit 6 [R. 335]. Presently appellee has pending in the United States District Court for the Eastern District of Wisconsin, an action against the licensee Victrylite Candle Company, for non-payment of royalties under the aforesaid license agreement [R. 79].

The appellant after knowing of the Wilson patent as early as September 23, 1949 [R. 100], was notified of, and requested to discontinue its infringement by letter dated April 26, 1950 [R. 336]. As will later appear, appellant was then making and selling candles so specifically like the showing in the Wilson patent that it could not possibly deny infringement, and consequently has admitted infringing from May 17, 1949 to September 5, 1952 [R. 46-47]. Thereafter appellant continued making the same type of candle, changed only in a minor respect [Deft. Ex. N], which the District Court had no difficulty in finding avoided neither the spirit or scope of the Wilson patent.



## Flame Coloring vs. Wax Coloring.

Our later discussion and understanding of the evidence, and particularly the physical exhibits, considered and demonstrated at the trial, can be clarified by first considering the nature and distinction between asserted candle flame coloring materials and wax coloring materials.

As the record will show, it is agreed that no relationship exists between the flame coloring properties of a metal, and the wax coloring properties of compounds of that metal. Note the following stipulation [R. 270]:

“Mr. White: That is right and since the defendant has asserted that it is following the teachings of Nelson and Fredericks, I want to prove with unmistakable clarity that what is said about the flame color producing properties of the metal is no teaching of what compounds of that metal will color a wax.

Mr. Lyon: I will stipulate to it.”

The testimony of Ira C. Bechtold [R. 258-273] proves the following:

1. Different metals when heated in *high temperature* flames will produce different characteristic colors.
2. In general, compounds (*e.g.* salts) of those metals have less color producing tendencies at corresponding temperatures.
3. The temperatures of candle flames *are not sufficiently high* to produce significant flame coloring, as represented by such patentees as Nelson and Fredericks, or to overcome the characteristic yellowish coloring of all wax candle flames.

4. Accordingly, those patents purporting to teach candle flame coloring are, in any realistic sense, unworkable and inoperative.
5. Therefore, it is inescapable that such patents as Nelson, Fredericks and Funke cannot be construed as any teaching of *wax coloring*, particularly as and for the purposes of the Wilson patent, because they say nothing about (a) making *drip* candles, or (b) of coloring the wax even if their candles would drip.
6. Plaintiff's Exhibits of the 18 series, prove the stipulated fact of no relationship between asserted flame coloring and wax coloring properties of metal compounds.

### The Findings and Conclusions of Law.

Since appellant has the burden of showing wherein the Findings of the District Court are clearly erroneous, or wherein the Conclusions of Law, and the Judgment are unsupported by those Findings, the essence of the appeal can perhaps best be presented to this Court by reference to the evidence which not only supports, but renders inescapable the validity of the Findings, the Conclusions of Law, and Judgment. Appraisal of any merit in the "Statement of Points for Defendant-Appellant" [R. 320] can readily be made in the light of the evidence that supports the Findings.

Since there appears to be no issue concerning Findings 1 to 4, 6, 7 and 9, we will consider only those remaining.

#### Finding 5.

"All the claims, 1 to 6, of the Wilson patent are alleged to be infringed. Defendant answered, alleging as defenses, non-infringement, invalidity of the claims in the Wilson patent, and file wrapper estoppel. After answering, de-

fendant in its 'Defendants' Statement of Issues Involved' of record in this Action, stated:

"From May 17, 1949 to September 5, 1952, defendant manufactured candles with different aniline dyes impregnated in the wick. Infringement by this candle will not be contested."

"Since September 5, 1952 defendants' candles have not had dyes in the wick. Infringement by this candle is in issue."

"This issue involves: Scope of claims, File wrapper estoppel, Limitations imposed by prior art."

#### **Remarks.**

There appears to be no disagreement concerning this finding.

#### **Finding 8.**

At the trial defendant relied upon the following prior patents and publications.

#### **UNITED STATES PATENTS.**

Patent No. 1,596,017; inventor Harnisch; issue date August 17, 1926.

Patent No. 1,608,518; inventor Minrath; issue date November 30, 1926.

Patent No. 1,701,844; inventor Funke; issue date February 12, 1929.

Patent No. 1,908,044; inventor Nelson; issue date May 9, 1933.

Patent No. 2,184,666; inventor Fredericks; issue date December 26, 1939.

Patent No. 2,196,509; inventor Turner; issue date April 9, 1940.

FOREIGN PATENTS.

Patent No. 95; country Great Britain; inventor Sterry; issue date 1871.

Patent No. 3478; country Great Britain; inventor As-cough; issue date 1871.

Patent No. 122; country Great Britain; inventor Fields; issue date 1871.

Patent No. 5902; country Great Britain; inventor Smith; issue date 1897.

Patent No. 157,209; country Germany; issued date December 28, 1904.

(Note: Of these, Funke and Nelson were considered by the Patent Office in the prosecution of the Wilson application.)

**Finding 12.**

At the trial defendant produced, demonstrated by burning, and the Court observed candles allegedly made in accordance with the disclosures in the patents and publications listed above in Finding No. 8. Among these prior patents defendant made particular reliance upon the United States patents to Funke, Nelson and Fredericks, which had for their primary objectives the making of candles which upon burning would have their flames colored by materials such as metal salts contained within the candles, and particularly applied to the candle wicks.

**Finding 13.**

None of the prior patents or publications relied upon by defendant refers to a drip candle, or reveals any contemplation of making a candle which characteristically is of a wax dripping type.

**Finding 14.**

It follows therefore that none of the prior patents or publications relied upon by the defendant contains any teaching of a multi-color drip candle which upon burning will produce successively differently colored drippings in the manner taught by the Wilson patent.

**Finding 15.**

The defendant's candle exhibits allegedly following the teachings of Funke, Nelson and Fredericks were inoperative to produce coloring of their flames upon burning, as the patentees represented that the flames would be colored.

**Remarks.**

Considering collectively Findings 8, 12, 13, 14 and 15, we submit that the very minimum requirements that any prior art must have to represent any pertinency or legal sufficiency in appellant's behalf, are that the asserted art at least pertain to the manufacture of drip candles, and that any particular showing relied upon be workable or operative for its intended purposes. As to the merits of the defense in these respects, the cross-examination of Mr. Muench [R. 147-231] is revealing, and we submit conclusive to the proposition that appellant has been unable to show in any prior patent an intent to produce a drip candle, whether colored or uncolored, and that the unworkability of the principal patents relied upon by appellant at the trial, all were openly admitted.

Note the following excerpts from Mr. Muench's testimony:

"Q. (By Mr. White): I recall your statement as being that you followed the teachings of these prior art patents, is that right? A. To the best of my ability.

Q. Mr. Muench, can you point out to me in any one of those patents the expression 'drip candle'? A. It is not disclosed in either one.

Q. In any of them as a matter of fact? A. No, I didn't come across that in any of them." [R. 152.]

"Q. (By Mr. White): One of their essential and outstanding requirements is that they be drip candles, is that not right? A. Yes, that is the purpose of the candle.

Q. Without being drip candles they would not perform as they are intended to perform, is that not right? (160) A. That is right." [R. 153.]

"Q. So far as the candles we see here, as your exhibits made allegedly in accordance with the prior art patents, is it not true that for all purposes of flame coloring you would consider them commercially unsatisfactory? A. Yes, I would certainly not produce any colored flame candles with the salts as so far produced." [R. 149.]

"Q. (By Mr. White): No one else has succeeded to your knowledge in making a satisfactory colored flame candle using any such expedients, isn't that true? A. Yes, so far, commercially." [R. 149.]

Following not what was taught by the prior art, but instead what we submit appellant had learned about the Wilson candle (distribution of which throughout the United States had started in 1945)

[R. 55], appellant commenced the manufacture in 1949 of its "Make-A-Rainbow" candle, which was significantly different from the bulk of its standard line of candles in that it was purposely made (by the use of a smaller wick size) to drip profusely.

"A. A 9-ply is smaller than the wick that we use in the standard candle.

The Court: What do you use in the standard candle?

The Witness: That particular candle in the gold box, we use a 30-ply. But we also use 24-ply in certain types." [R. 156.]

At the trial, appellant apparently hoped to prove its defense principally by demonstrations of exhibits assertedly made in accordance with the Nelson and Fredericks patents. Perhaps the most remarkable thing about its attempted proofs was that appellant in its eagerness to color the candle drippings, ignored completely the intended flame coloring purposes of the patents, and in the course of its demonstrations, proved rather conclusively the unworkability of its own exhibits. Further, and as the record will show, for whatever these flame coloring patents may be worth, appellant was required to strain far beyond any apparent disclosures in the patents to produce colored drippings. Surprisingly, appellant had to admit that in its flame coloring candle exhibits, allegedly capable of wax coloring, the exhibits contained asserted coloring materials that were not even mentioned in the references. The following excerpts are revealing:

"Q. (By Mr. White): Mr. Muench, in your testimony concerning Defendants' Exhibit D pur-

portedly following the Nelson patent, I believe you stated that the candle is made using a 9-ply wick coated successively with copper acetate, iron salts, copper chloride and cadmium sulphide, am I correct? A. Yes, sir." [R. 158 and 159.]

"Q. Now, the second material, iron salts; what iron salts? A. Well, I suppose they all have different names. This one, if you want to pin this down to a certain angle, I can give it to you. I can't even pronounce it. It is spelled—this iron salt that we use from du Pont is spelled d-i-c-h-l-o-p-e-n-t-a-d-i-e-n-y-l-i-r-o-n." [R. 160.]

"Q. Do you find reference to that compound in the Nelson patent? A. No, I don't. Not by that name, anyway." [R. 161.]

"Q. (By Mr. White): The fourth compound used in Exhibit D is cadmium sulphide; do you find any reference in Nelson to cadmium sulphide? A. No, I don't." [R. 161.]

"Q. Do you mean that you prepared that exhibit purportedly in accordance with Nelson without knowing what color the compound or any part of it is supposed to color the flame according to Nelson? A. In some case, I would say yes, I wasn't particularly interested in coloring the flame in that particular sense. But the strontium that is mentioned here was supposed to color flames." [R. 164.]

"Q. D-1, Mr. Muench. That is a second candle purportedly made in accordance with Nelson. In that I believe you testified that you used orange red 621, and that is supposed to be cadmium sulphide selenide. Do you find any reference to such a compound in Nelson? A. No, I don't.

Q. Next you named copper acetate. Do you find copper acetate in Nelson? A. As I said before, no.



Q. Next you referred to Brown C-59, which is supposed to be a spinel of iron, chrome and magnesium. You find any reference in Nelson to any kind of a spinel? A. Here is selenium salts." [R. 165.]

"Q. So in this instance we find only one out of four compounds named in Nelson, namely copper chloride, that being a halide of copper, is that correct?" [R. 165.]

"So am I not correct in stating that in the preparation of Exhibit D-2 you used only one compound, one out of the four mentioned by Nelson? A. There is selenium used here and the orange red 621.

Q. Is cadmium sulphate selenide mentioned? A. No, not the combination." [R. 166.]

In their failure to follow any discernible teachings in Nelson, Defendant's Exhibits D, D-1 and D-2 are in the same category. Note particularly the fact that appellant avoided presenting to the Court, candles made according to the two examples in the Nelson patent [R. 168-170].

"Q. Now let us refer to your Exhibits E and E-2, purportedly made according to the Fredericks patent.

I believe you testified that Exhibit E contains in succession copper acetate, iron salts, copper chloride, cadmium sulphide.

What iron salts did you use? A. That is the one made by Du Pont with the long name.

Q. Did you find a reference to it in the Fredericks patent? A. Not by that long name, no, but I think he does mention iron salts, doesn't he?

Q. Aren't there a great many iron salts? A. Yes, there are.

Q. Did you try any other iron salts? A. Yes, we tried some other iron salts, that one that we used here in the spinel.

Q. But alone, did you try and find any other iron salts alone that would work satisfactorily in drip candles to color the wax? A. No, not salts as such. We tried a number of different salts originally, in fact, I even tried pieces of metal, rusted metal in there, which certainly colored the wax.

Q. Would you use them in the manufacture of a multi-colored drip candle? A. Not for commercial purposes." [R. 171.]

"Q. In the Fredericks patent do you find reference to cadmium sulphide, or any cadmium compound? A. No. There is copper and calcium mentioned, and serium." [R. 171.]

"Q. Fredericks refers to water soluble salts, doesn't he? A. I believe it does in certain cases.

Q. Are the iron salts that you use water soluble? A. Not to any extent." [R. 171 and 172.]

"Q. Continuing now on your Exhibit E-2, which I believe you testified was made to contain successively Orange Red 621, Blue No. 1, being a cobalt aluminate, (3) copper acetate, and (4) Brown C-59. Which of those four chemical compounds do you find mentioned in the Fredericks patent? Any of them? A. There is copper mentioned.

Q. Any cadmium sulfo-selenide? A. This blue has aluminum, and this calls it aluminate. This calls for aluminum.

Q. I understand Blue No. 1 to be cobalt aluminate. Do you find it in the Fredericks patent? A. Cobalt—I don't find cobalt mentioned, but I do find aluminum mentioned.

Q. Do you find any combination—will aluminum color the wax? A. No. But undoubtedly in combination with a cobalt it does.

Q. Therefore, cobalt aluminate means something different from aluminum, doesn't it? A. Well, it is a mixture, yes, but it still has aluminum in it, as I understand it.

Q. But you don't find anything in Fredericks that corresponds to cobalt aluminate, isn't that true? A. No, but does Fredericks just limit himself to . . .” [R. 172.]

As in the case of the Nelson patent, appellant avoided attempting to present any exhibits corresponding to the three specific examples in the Fredericks patent, and for good reason insofar as any success it would have had in producing colored drippings, as developed in the further testimony of Mr. Muench [R. 173-181]. Also exhibited were candles allegedly made in accordance with the British Field and Sterry patents, the German Hausamann patent, and a sample of appellant's Star Pillar candle, Exhibit P. How these can have any conceivable bearing on the Wilson patent in any factual or legalistic sense is difficult to perceive. As with all the publications, the British and German patents don't even mention drip candles, and none of them, including also appellant's Star Pillar candle, shows any intent or capacity to produce multi-color drippings.

“Q. Referring to your exhibits I, I-1 and I-2, the British Field patent, I believe you testified, Mr. Muench, that such a candle even if it were a drip candle could not burn in any manner productive of successively formed different colored drippings, is

that not right? A. That is right. They would have a tendency to blend along the length of the handle.

Q. And the British Field patent says nothing about making any drip candles, is that right? A. That is right.

Q. We are in agreement that your Exhibit O, the rope candle, is not a multicolored drip candle?

A. Which candle was that?

Q. Your rope candle. A. The 117 rope, no; that is a single core candle, single color.

Q. And the Star Pillar candle, Exhibit P, is not a multicolored drip candle?

Mr. Lyon: Do you mean Exhibit F?

Mr. White: Is it Exhibit F?

Mr. Lyon: Right.

Mr. White: I am sorry. Stand corrected on that.

The Witness: That is a single core, color candle." [R. 181 and 182.]

"Mr. White: In reference now to Defendant's Exhibit H, a candle purportedly made according to the German Hausamann patent, as I recall your testimony this is a candle made, using a 9-ply wick?

The Witness: Yes.

Q. (By Mr. White): Is there anything said in the Hausamann patent as to its being a drip candle? A. No.

Q. Are there any multiple coloring materials in the candle? A. No. One color at a time." [R. 182 and 183.]

Liberties certainly were taken in the making of Appellant's Exhibit G.

"Q. Now, I am particularly concerned about your direct testimony relating to Exhibit G, the Sterry

British patent. I believe you testified, Mr. Muench, that in the preparation of that exhibit you ironed into the wick successively aniline blue, aniline pink, and aniline violet dyes; am I correct? This patent says nothing about forming drippings, am I not right? A. No, it does not call for drippings." [R. 183.]

"Q. (By Mr. White): Now where in the Sterry patent, Mr. Muench, do you find any reference to coating the wick successively with blue, pink and violet aniline dyes? A. I combined the three in the one candle. It does not mention it in the patent that they use more than one color at a time, but it mentions the three of them as using any or all of them, I take it." [R. 186.]

"The Court: You had better ask him over again because he was talking about another Exhibit G.

The Witness: That one in Mr. Lyon's hand is with one color on the wick, blue.

Q. (By Mr. White): Would that not be more in keeping with the teachings of the patent than what I have in my hand? A. In that it only has one color, yes.

Mr. White: May we have that in evidence, please?

Mr. Lyon: That is agreeable.

The Court: We will call that G-2.

(The exhibit referred to was received in evidence and marked Defendants' Exhibit G-2.)

Q. (By Mr. White): The one I hold in my hand does not correspond with any description in the Sterry patent, is that not right? A. If you are referring to the three colors . . .

Q. Right. A. That is right." [R. 187 and 188.]

**Finding 9.**

The Wilson patent relates to a novel drip candle, so characterized by its formation of wax drippings as the candle burns, which produces during burning and in an unpredictable sequence by reason of the concealment of different coloring materials in the candle, a succession of distinctly and differently colored drippings resulting from the melting of at least a portion of the candle body wax and its acquisition of successively different colors which said portion of the wax would not have before melting. The Court finds this candle to be unique in the candle making art.

**Finding 10.**

Defendant admits having had no knowledge of the manufacture or sale of any candle as defined in the preceding Finding 9 prior to the making of defendant's "Make-A-Rainbow" candle, or prior to March 13, 1945, the filing date of the application for the Wilson patent.

**Remarks.**

These findings are clearly supported by appellants' own answers to the following interrogatories [R. 81-83]:

"Question No. 1: Concerning the allegations in paragraph 8 of the Answer, state whether to defendant's knowledge a candle defined as follows:

"A drip candle having a wax body and containing within its interior different wax-soluable dyes at different locations longitudinally of the body, the different dyes being concealed with the candle body and being undissolved in any substantial portion of the body wax before the candle is burned, the dyes dissolved in the said portion of the body wax as the

candle burns with resultant formation of a composite of different colored drippings as the candle progressively burns.

"A. Had prior to March 13, 1945, been manufactured in the United States, other than by plaintiff, and if so, state:

- "1. The name and address of the manufacture;
- "2. The time of manufacture; and
- "3. The manufacturer's identification of all such candles.

"B. Had prior to March 13, 1945, been sold in the United States, other than by plaintiff, and if so, state:

- "1. The name and address of the seller;
- "2. The time of sale; and
- "3. The seller's identification of all such candles.

"Answer: A. No.

"Answer: B. No.

"Question Two:

"Concerning the allegations in paragraph 8 of the Answer, state whether to defendant's knowledge, a wax body candle containing and concealed within its interior before burning, different wax coloring materials at different longitudinal locations in the candle body and undissolved in a substantial portion of the body wax, in a manner such that upon burning the candle forms a composite of different colored drippings which become colored by said wax coloring materials.

"A. Had prior to March 13, 1945, been manufactured in the United States, other than by plaintiff, and if so, state:

- "1. The name and address of the manufacturer;
- "2. The time of manufacture; and



"3. The manufacturer's identification of all such candles.

"B. Had prior to March 13, 1945, been sold in the United States, other than by plaintiff, and if so, state:

"1. The name and address of the seller;

"2. The time of the sale; and

"3. The seller's identification of all such candles.

"Answer: A. No.

"Answer: B. No."

"Question 7: If defendant refers in its answer to Interrogatory V, to any candle of its manufacture and sale, state whether defendant knew of any manufacture, use, sale, or description of a similar multiple color drip candle, (other than those manufactured or sold or described by plaintiff herein) prior to defendant's manufacture and sale thereof, and if so, identify fully the prior manufacturer, user, seller of source of description.

"Answer: No." [R. 84.]

"Question 8: If defendant refers in its answer to Interrogatory VI, to any candle of its manufacture and sale, state whether defendant knew of any manufacture, use, sale or description of a similar multiple-colored drip candle (other than those manufactured or sold or described by plaintiff herein) prior to defendant's manufacture and sale thereof, and if so, identify fully the prior manufacturer, user, seller of source of description.

"Answer: No." [R. 85.]

"Question 20: Describe and identify any candles (other than those manufactured by plaintiff) publicly sold on any market prior to defendant's 'Make-a-Rainbow' candle which upon burning produced



similarly, in an unpredictable sequence by reason of the concealment of different coloring materials in the candle, a succession of distinctly and differently colored drippings resulting from the melting of at least a portion of the candle body wax and its acquisition of successively different colors which said portion of the wax did not have before melting.

“Answer: Defendant has no knowledge of any such candles.” [R. 89.]

#### **Finding 16.**

Flame coloring candles according to the teachings of Funke, Nelson and Fredericks were not known by defendant to have been sold on any market prior to the filing of the Wilson patent application.

#### **Remarks.**

“Question 16: (a) To defendant’s knowledge have candles manufactured as described in any of the patents referred to in Interrogatory 15, been sold in the market in the United States or any other country prior to 1945.

“(b) If the answer to the foregoing is in the affirmative, state the name and address of all such manufacturers or sellers known to defendant.

“Answer: (a) No.

“(b) No answer required.” [R. 89.]

#### **Finding 11.**

From May 17, 1949 to and including September 5, 1952, defendant manufactured and sold under the trade-mark “Make-A-Rainbow,” candles which were provided with cotton wicks to which were applied different colored wax, colored by wax-soluble aniline dyes, disposed successively on different portions of the wick along its length,

the candles being finished from such prepared wicks by dipping in white wax to candle size. Infringement of the Wilson patent by those candles so made from May 17, 1949 to September 5, 1952, is admitted by defendant.

That candle was discontinued by defendant September 5, 1952, and since that date defendant's candles have been manufactured by first dipping a wick to form a thin white wax taper of substantially  $\frac{1}{4}$  inch thickness upon which there is then painted in successive spaced portions molten wax containing aniline dyes of different colors. The candle is then finished by further dipping to produce a finished candle of about 1 inch maximum diameter, having the colored wax portions covered and concealed with the uncolored wax. The last mentioned candles have been sold under the trademark "Make-A-Rainbow" from September 5, 1952 to date.

Defendant's "Make-A-Rainbow" candle have been sold by it within the jurisdiction of this Court following notice to defendant of the Wilson patent.

#### Remarks.

"Q. 10: (a) Is the following a true statement concerning defendant's activities up to August 1, 1953?

"From May 17, 1949, to and including September 5, 1952, Muench Kreuzer Candle Company manufactured and sold under the trade-mark 'Make-a-Rainbow' candles which were provided with cotton wicks in which were incorporated various types of aniline dyes disposed successively in different portions of the wick so that on burning the candle presented successively different colored drippings.

"This candle was discontinued September 5, 1952. and all models have been disposed of so that none is available from the defendant for production. Since

September 5, 1952, defendant's candles have been manufactured by first dipping a wick to form a thin taper of substantially one-fourth inch thickness upon which there is then painted in successive spaced portions molten wax containing aniline dyes of different colors. The candle is then finished by further dipping to produce the finished candle, having the colored wax portions covered by uncolored wax.

"The percentage of aniline dye to wax in the material which is painted upon the thin taper is within the range of percentage of due to wax customarily used by defendant and other candle makers in making solid-colored candles. These candles have been sold under the trade-mark 'Make-a-Rainbow' and were recently under the trade-mark 'Color Fall.' Such candles have been sold from September 5, 1952, to date (*i.e.*, August 1953).

"(b) If the foregoing quoted statement is incorrect in any respect please state wherein it requires correction.

"(c) If defendant has manufactured or sold subsequent to August 1, 1953, any candles of the same type as its 'Make-a-Rainbow' and 'Color Fall' candles but of different compositions, describe fully all such different compositions and the procedure of making them into candles, and give the name under which they have been sold.

"Answer: (a) Yes, with the explanation set forth in answer to Interrogatory 10(b).

"(b) At no time did the defendant manufacture a candle in which aniline dyes were directly incorporated in the wick. Defendant's practice, in accordance with the ancient 'muetter farben' (mother color) practice, *was to use a colored wax* which, in the period prior to 1952, was applied directly to the wick and since said period has been applied to a

thin taper or core. The statement in Interrogatory 10 concerning the range of percentage of dye to wax is really meaningless in that this percentage varies in accordance with the strength of the particular batch of dye, the type of the dye and the overall color desired. Mother color is, however wax incorporating a rather concentrated dye." (Italics added.)

"The body of the candles is a mixture of paraffine and stearic acid. The wick is braided cotton nineply.

"(c) Defendant has made no changes in its colored drip candles since August 1, 1953." [R. 86, 87 and 88.]

#### **Finding 17.**

Plaintiff commenced manufacture and sale to customers in various parts of the United States, including the Western states, of his "Magi-Color" candles made in accordance with the Wilson patent, and in a manner similar to defendant's first "Make-A-Rainbow" candles, within a month following the filing of the application for the Wilson patent.

#### **Remarks.**

Mr. Wilson testified [R. 58] that he commenced manufacture and sale to customers as found by the Court in 1945 [R. 56], Plaintiff's Exhibit 15. Appellant's answer to Interrogatory 10 as set forth above, shows that appellant applied wax-colored dye to the wicks in its first-manufactured "Make-a-Rainbow" candles, exactly as described in the Wilson patent.

#### **Finding 18.**

In the burning of defendant's "Make-a-Rainbow" candle manufactured since September 5, 1952, the dyes applied

to the wax taper dissolve in the candle drippings as they are formed, in essentially the same manner as the drippings were colored in defendant's first-manufactured "Make-a-Rainbow" candles in which the colored wax was applied directly to the wick.

**Remarks.**

Mr. Muench admitted the essential sameness of both candles, *i.e.*, prior and subsequent to September 5, 1952 [R. 226-229]. Note the following concerning Defendant's Exhibit N.

"Q. And the taper of No. 2 is about a quarter inch? A. A quarter to three-eighths.

Q. So the bulk of the wax in the candle has been gained by building up on the taper? A. Yes, sir.

Q. So, therefore, we have the main bulk or body of the candle represented by the wax which has been applied in tapers Nos. 3 and 4? A. Yes.

Q. As you make these candles, as they go out on the market, they appear as we see them here in No. 5, do they not? A. Yes.

Q. The coloring materials are concealed in the candle, are they not? A. Yes, sir." [R. 226-227.]

"Q. When finished candle No. 5 is burned, the heat developed by the wick flame melts the wax adjacent the flame, does it not? A. Yes, sir, it melts the candle wax.

Q. And as the candle wax melts the dye which we see on taper No. 2 simply goes into solution in the melted wax, does it not? A. More or less, yes, sir.

Q. And as the wax accumulates, being colored, the candle tends to crater and spill over, at least at one side, and thus we have the formation of the colored dripping? A. Yes." [R. 228.]

“Q. But insofar as what dissolves in the wax is concerned, in both instances the dye dissolves in the wax in essentially the same way? A. Yes.

Q. That was true of your first Make-a-Rainbow candles, was it not? A. Yes.” [R. 228.]

### Finding 19.

Defendant purposely renders its “Make-a-Rainbow” candles capable of profusely dripping by the use of a smaller wick (9 ply and similar to the wick size employed in plaintiff’s “Magi-Color” drip candles) than is used by candle manufacturers in general, and including defendant, in candles which are not made especially to drip.

“Q. How long have you, Mr. Muench, as a candle manufacturer, known what makes candles drip? A. Possibly from the beginning of my inception in the candle business where I gradually learned the details of it.

Q. And that is general knowledge in the candle industry, isn’t it, among candle manufacturers? A. That is right.” [R. 94.]

(By Mr. Muench):

“These candles are made particularly, as all these supposed multi-colored drip candles, with a small wick so they haven’t the capacity to carry the amount of wax.

Any of these candles in a room that has no draft—for instance, with the so-called drip candles—if they are put in with a large wick, won’t drip at all if there is no draft, so they are not really a dripping candle unless the wick is small.” [R. 118.]

“Q. But your company has been making both types? This would be what you might call a pro-

fusely dripping candle, is that no right? A. Yes, sir.

Q. And your company manufacturers those which drip little, and the candles which drip a good deal; is that not right? A. Well, you might say that, yes." [R. 93.]

#### **Finding 20.**

The Court further finds that suit was filed on December 5, 1949 in the United States District Court, for the Eastern District of Wisconsin, by plaintiff for infringement of the Wilson patent, against Victrylite Candle Company of Oshkosh, State of Wisconsin, in an Action 6354 entitled "Complaint for Infringement of Patent," which suit after answer by the defendant therein, was concluded by consent decree dated May 5, 1950, holding the Wilson patent valid and infringed; and the Court further finds that plaintiff granted to the said Victrylite Candle Company, by agreement dated April 18, 1950, a license, the granting clause in which reads:

"Reserving in himself, his successors and assigns a single and indivisible right of manufacture, use and sale of candles embodying the invention of said patent, Licensor hereby grants to Licensee an otherwise exclusive license under said patent limited, however, to the manufacture, use and sale of candles having dyed cores as distinguished from dyed wicks and comprising at different points axially of the candle at least two different core colors."

#### **Remarks.**

This finding is supported by the testimony of appellee [R. 58-65] and Plaintiff's Exhibits 5, 7, 8 and 9.



## Appellant's Specification of Errors.

The facts as demonstrated in the foregoing, together with further references to the Record, will show appellant's exceptions to be without merit.

### I.

The District Court erred in concluding that Claims 1 to 6 and each of them of the patent in suit No. 2,464,361 are good and valid in law.

### II.

The District Court erred in failing to find that Patent No. 2,464,361 and each of the claims thereof are invalid and void for want of invention over the prior art.

### Remarks.

In view of appellant's own admissions that the patent prior art fails even to mention the subject of drip candles, and the complete absence in the prior art of any mention whatever of multi-color drip formation by a single candle, the District Court could not find otherwise than that claims 1 to 6 are good and valid in law.

### III.

The District Court erred in failing to find that Patent No. 2,464,361 and each of the claims thereof are invalid and void and unenforceable for having been procured by a fraud perpetrated upon the United States Patent Office by reason of a false representation made in plaintiff's brief on Appeal to the Patent Office Board of Appeals that "The metallic salts and the like employed for flame coloring in the references are not dyes, they are not wax soluble, and they would not affect the color of drippings if the candles were of the drip producing type."



Remarks.

Attention is directed to appellant's answer to interrogatory 18 [R. 202-205] in which appellee had asked appellant *which of 146 compounds and metals* alleged by Nelson and Fredericks to be useable for flame coloring were "capable of practical and workable use in the making of candles like or similar to defendant's 'Make-a-Rainbow' or 'Cascade' candles, and for the effective coloring of drippings produced upon burning of the candles.

In answering, appellant listed 18 materials, 8 of which admittedly were not to be found in either patent [R. 205-213]. Of the remaining 10, appellant undertook to demonstrate that copper acetate and copper chloride would work practicably to color the wax. Copper acetate, relied upon by appellant as its main hope, was used by neither Nelson nor Fredericks in any of their specified examples, and nowhere was this compound specifically mentioned as such, *i.e.*, "copper acetate." The extremity of appellant's need for a compound by which it might work out some semblance of a case, is obvious from its failure to show that even the metal acetate as a class would be workable (which they would not).

We again point to appellant's refusal to demonstrate to the District Court, candles made according to the examples in Nelson and Fredericks, although directly challenged to do so at the beginning of the trial [R. 457]. In view of this refusal and appellant's featuring in its exhibits of copper acetate, which is 1 out of 146 compounds or metals allegedly flame coloring, appellant is in no position to question Wilson's representations to the Patent Office. Appellant itself has demonstrated their validity.

IV.

The District Court erred in concluding that candles manufactured by defendant-appellant since September 5, 1952, infringe Claim 1 of Patent No. 2,464,361.

**Remarks.**

The record is clear that since September 5, 1952, appellant's candles have been "drip" candles containing "different wax-soluble dyes normally concealed within the interior of the body at different locations longitudinally thereof and normally undissolved in the wax of said body" so that upon burning of the candle, the dyes "dissolving in the melted wax of the body to form multi-colored drippings as the candle progressively burns."

Appellant first applied differently dyed waxes directly to the wick, exactly as described in the Wilson patent, and later departed from this practice only by moving the colored wax outwardly  $\frac{1}{8}$  inch from the wick [Ex. N]. The colored wax still remained concealed, near the wick and occupied the same very minor volume relative to the white bulk or body of the candle [R. 251].

V.

The District Court erred in concluding that "Examination of the file history of the Wilson patent application reveals no estoppel against plaintiff's assertion of validity and infringement."

**Remarks.**

The observations under Specification of Error III above, show that there can be no estoppel as to validity, on any factual or legal basis concerning representations made to the Patent Office.

As to infringement, the Patent Office file history will show that throughout, Wilson continued to assert the patentability of claims as broad as claims 1 to 6 in the patent. Wilson canceled differently worded claims in an effort to satisfy the Examiner, but at no time did he relinquish his position of patentability in broader claim 1, as well as the more specific claims 2 to 6.

## VI.

The District Court erred in failing to conclude that Claim 1 of Patent No. 2,464,361 is limited to a candle in which the dyes are “normally undissolved in the wax of said body” and hence not infringed by candles as manufactured by defendant-appellant since September 5, 1952, in which the dyes, prior to application to the taper, are first dissolved in wax.

### Remarks.

Claim 1 does not limit the dye portion to being on the wick. Appellant has admitted infringement of the patent (claims 2 to 6) prior to September 5, 1952, when as later, the dyes were “first dissolved in wax” and applied to the wick. Surely it cannot be seriously contended that claim 1 is avoided simply by moving the same dyed wax outwardly  $\frac{1}{8}$  inch.

We contend, and appellant has not been able to show the contrary, that the Wilson invention was highly original in the art, that there is nothing whatever in that art to warrant any narrowing interpretation of claim 1 that would show its avoidance by applicant's candles since September 5, 1952, and that appellant's own witness admitted the direct similarity of its candles before and after 1952 [R. 226-229].

## VII.

The District Court erred in concluding that the prior art relied upon by defendant does not support defendant's contentions of invalidity in view of the rules and laws as laid down in *J. A. Mohr & Sons v. Alliance Securities Co.*; *Standard Oil Company v. Same* (C. C. A. 9, 1926), 14 F. 2d 799; *Flakice Corporation v. Liquid Freeze Corp.*, (D. C. N. D. Cal., 1955), 130 Fed. Supp. 471; *Derwey & Almy Chemical Company, et al. v. Mimex Company, Inc.* (C. C. A. 2), 124 F. 2d 986.

### Remarks.

The direct applicability of these decisions to the facts of this case will be shown later.

## VIII.

The District Court erred in concluding that Victrylite Candle Company is neither a necessary nor indispensable party in this Action.

### Remarks.

The facts and applicable law are discussed later.

## IX.

The District Court erred in concluding that plaintiff is entitled to an injunction and an accounting for profits and damages by reason of defendant's infringement.

The complete failure of appellant to prove either invalidity, non-infringement, estoppel or lack of indispensable party, rendered inevitable the decision given.

## X.

The District Court erred in failing to find that all candles drip.

**Remarks.**

The District Court could not properly have made this finding in view of appellant's own admission [R. 118] that a candle is "not really a dripping candle unless the wick is small."

**XI.**

The District Court erred in refusing to find, as requested by defendant, that certain of the metallic salts listed in the Fredericks Patent No. 2,184,666, when placed in sufficient quantities on the wick of a candle which drips, with color the drippings of said candle, specifically including copper acetate, cuprice chloride, copper hydroxide and ferric oxide.

**Remarks.**

Fredericks made a very generalized statement about allegedly workable, but factually unworkable, flame coloring salts. He says nothing about "a candle which drips," and nothing about the use of any salts for wax coloring.

**XII.**

The District Court erred in failing to find, as requested by defendant, that the use of aniline dyes, both in the wick and as a dye to color the core of a candle a different color than the main body of a candle was old in the art prior to the time when plaintiff made the invention embodied in the patent in suit.

**Remarks.**

The point is irrelevant since appellant has admitted repeatedly that no prior art teaches a candle capable of forming multi-colored drippings, which is of the essence of the Wilson patent.

XIII.

The District Court erred in finding that none of the prior patents or publications relied upon by defendant refers to a drip candle, or reveals any contemplation of making a candle which characteristically is of a wax dripping type.

Remarks.

Appellant admitted that none of the prior patents says anything about drip candles [R. 118].

XIV.

The District Court erred in failing to find that since 1941 defendant has manufactured and sold, and advertised in its catalog its Star Pillar candles in which wax colored differently than the exterior of the candle drips upon burning.

XV.

The District Court erred in failing to find the German Patent 157,209 of December 28, 1904, discloses a candle which upon burning drips a wax over the exterior of the candle colored differently than said exterior.

XVI.

The District Court erred in failing to find that Great Britain Patent 95 of 1871 discloses a candle which upon burning drips a wax over the exterior of the candle colored differently than said exterior.

Remarks.

XIV, XV and XVI are irrelevant since none of these candles is a multi-color drip candle.

## XVII.

The District Court erred in failing to conclude that the patent in suit discloses a mere multiplication of defendant's Star Pillar candle, or of said candle of said German patent No. 157,209 or of said British Patent No. 95 of 1871 and hence no invention over the prior art.

### Remarks.

"A mere multiplication" of any of these could at best amount to nothing more than an elongation of same candle. Not one of these has the characteristics emphasized in our discussion under "The Wilson Patent," *supra*, and consequently invention in the Wilson patent is inescapable because Wilson created a candle (1) structurally and compositionally different, which (2) performed in a new manner obviously beyond the contemplation of appellant in its "Star Pillar" candle, or of the German or British patents.

### Indispensability of Victrylite Candle Company in This Action.

Finding 20 of the District Court recites the following granting clause in appellee's license to Victrylite Candle Company of Oshkosh, Wisconsin [R. 17-18].

"Reserving in himself, his successors and assigns a single and indivisible right of manufacture, use and sale of candles embodying the invention of said patent, Licensor hereby grants to Licensee an otherwise exclusive license under said patent limited, however, to the manufacture, use and sale of candles having dyed cores as distinguished from dyed wicks and comprising at different points axially of the candle at least two different core colors." [R. 17-18.]



Appellant's arguments concerning the necessity or indispensability of Vicrylite in this action most obviously are as lacking in legal support as are its defenses of invalidity, non-infringement and estoppel. In no true sense was the license grant exclusive. Vicrylite was granted no right whatever under claims 2 to 6 of the patent and as to the broader subject matter of claim 1, appellee reserved "in himself, his successors and assigns a single and indivisible right of manufacture, use and sale of candles embodying the invention of said patent." As the Court found, candles having dyed cores embody the invention of the Wilson patent.

The following cases are applicable:

In *Zenith Radio Corp. v. RCA*, 121 Fed. Supp. 803 (D. C. Del., 1954), Zenith moved to dismiss a counterclaim for defect of parties, urging the indispensability of the absent parties because they held rights in the counterclaimed patents tantamount to co-ownership. The court said:

"Zenith to succeed in its argument must show transfer of 'an undivided portion of the entire interest in the invention' to the absent parties. They must be 'upon equal footing with the patentees' (RCA, GE, WE) 'in all respects' for the 'undivided part assigned' in the counterclaim patents. If the agreements leave in the patentees any distinct rights in the area of their grant not exercisable by grantees, they confer only licenses and pass no property in the monopoly. Cf. *Waterman v. MacKenzie*, 138 U. S. 252, 34 L. Ed. 923. If licensees, AT & T and Westinghouse are not indispensable parties Zenith admits."



In *Min-A-Max Co., Inc. v. Sundholm*, 24 Fed. Supp. 89, 38 U. S. P. Q. 220 (D. C. N. D. Iowa, 1938), the defendant in an infringement suit pleaded defect of parties, alleging Min-A-Max had granted a substantially exclusive license to Steward Warner Corp., with reservations "constituting what defendant termed were mere shop rights," that is reserving rights to manufacture and sell to a specified limited trade, and the court said:

"I find that the license pleaded and adduced in evidence was granted to Steward-Warner Corp. but construe it as being a non-exclusive license, and hold that there is no defect of parties, thus disposing of the question of practice."

In *Bakelite Corp. v. Lubri-Zol Development Corp.*, 34 Fed. Supp. 142 (D. C. D. Del., 1940), in a declaratory judgment suit against defendant patent owner, the court held that defendant's exclusive licensee need not be joined.

In *Bowers v. Atlantic, Gulf and Pacific Co.*, 162 Fed. 895 (C. C. S. D. W. Va., 1907), in an infringement suit, the patentee's exclusive licensee to use and build in designated territory, subject to a reservation in patentee of the right to build in that territory, was held a proper party and not a necessary party.

In *Comptograph Co. v. Universal Accountant Machine Corp.*, 142 Fed. 539, in an infringement suit the court held that the patentee need not join his sole licensee.

In *Frankfort Whiskey Process Co. v. Pepper*, 26 Fed. 336 (C. C., S. D. N. Y., 1885), in an infringement suit brought by the grantee of the patent, the court held that the grantor who had reserved the right to use and to license others to use the process of the patent was not a necessary party plaintiff.

In *Nellis v. Pennack Mfg. Co.*, 13 Fed. 451 (C. C. E. D. Penn., 1882), in a suit by an assignee for infringement the court held that an exclusive licensee to manufacture and sell under the patent was not an indispensable party.

In *Waterman v. MacKensie*, 138 U. S. 252, 34 L. Ed. 923, the Supreme Court stated:

“The patentee or his assigns may, by instrument in writing, assign, grant and convey, either, 1st, the whole patent, comprising an exclusive right to make, use and vend throughout the United States; or 2nd, an undivided part or share of that exclusive right; or 3rd, the exclusive right under the patent within and throughout a specified part of the United States. \* \* \* a transfer of either of these three kinds of interest is an assignment, \* \* \* any assignment or transfer short of one of these is a mere license, giving the licensee no title in the patent, and no right to sue at law in his own name for an infringement.”

Appellant cites *Waterman v. MacKensie*, 138 U. S. 252, 34 L. Ed. 923. Obviously appellee's grant to Vicrylite does not meet any of the three requirements laid down in this decision by the Supreme Court. Accordingly, the facts and cases fully support the District Court's conclusion of law:

5. Vicrylite Candle Company is neither a necessary nor indispensable party in this Action [R. 19].

## Applicable Cases Re Asserted Invalidity of the Wilson Patent.

In its conclusions of law, the District Court held:

“4. The prior art relied upon by defendant does not support defendant’s contentions of invalidity in view of the rules and laws as laid down in *J. A. Mohr & Sons vs. Alliance Securities Co.*; *Standard Oil Company vs. Same* (Ninth Circuit Court of Appeals 1926), 14 F. 2d 799; *Flakice Corporation vs. Liquid Freeze Corp.*, 130 F. Supp. 471 (D. C. N. D. Cal., 1955); *Dewey & Almy Chemical Company, et al. vs. Mimex Company, Inc.* (Second Circuit Court of Appeals), 124 F. (2d) 986.” [R. 18.]

These cases are squarely in support of appellee’s case in that they fully bear out the general proposition that a defendant in a patent infringement action cannot make out a valid defense by distortions or attempted conversion of prior art into something foreign to any contemplations of that art, and particularly where, as here in the case of the asserted followings of Nelson, Funke and Fredericks, the defendant convincingly proves the unworkability or inoperativeness of the prior art for its intended or represented purposes.

First we have Judge Learned Hand’s statement of the governing rule, in *Dewey & Almy Chemical Company et al. v. Mimex Company, Inc.* (C. C. A. 2), 124 F. 2d 986, that:

“No doctrine of the patent law is better established than that a prior patent or other publication to be an anticipation must bear within its four corners adequate directions for the practice of the patent

invalidated. If the earlier disclosure offers no more than a starting point for further experiments, if its teaching will sometimes succeed and sometimes fail, if it does not inform the art without more how to practice the new invention, it has not correspondingly enriched the store of common knowledge, and it is not an anticipation.”

Certainly the publications relied on by appellant failed by Mr. Muench’s own admissions, to “bear within its four corners adequate directions” for practice of the Wilson patent. Furthermore, to concede that the earlier disclosures relied upon by appellant offered even “a starting point for further experiments,” would be to dignify them beyond any value which they were shown to have at the trial. The publications did not even conceive of any end objective of a multi-color drip candle.

Directly in point also is the decision of this Court in *J. A. Mohr and Sons v. Alliance Securities Co.*; *Standard Oil Company v. Same* (C. C. A. 9, 1926), 14 F. 2d 799, wherein the Court stated:

“It is to be borne in mind that the prior art here relied upon consists entirely of patents, and that when it is sought by means of prior patents to ascertain the state of the art, ‘nothing can be used except what is disclosed on the face of those patents. They cannot be reconstructed in the light of the invention in suit, and then used as a part of the prior art.’ *Naylor v. Alsop Process Co.*, 168 F. 911, 94 C. C. A. 315; *Frey v. Marvel Auto Supply Co.*, 236 F. 916, 150 C. C. A. 178. And the presumption that a patented combination is new and useful and embodies invention has added force where, as here, it appears that the patents relied upon as showing anticipation were considered by expert patent office officials.

While their judgment is not absolutely binding on a court, it is entitled to great weight and is to be overcome only by clear proof that they were mistaken and that the combination lacks patentable novelty. *Fairbanks v. Stickney*, 123 F. 79, 59 C. C. A. 209; *Hale & Kilburn Mfg. Co. v. Oneonta, C. & R. S. Ry. Co.* (C. C.), 129 F. 598; *MacClemmy v. Gilbert Corset Co.* (D. C.), 221 F. 73; *New Jersey Wire Cloth Co. v. Buffalo Expanded Metal Co.* (C. C.), 131 F. 265."

The District Court for the Northern Division in California, had occasion in *Flakice Corporation v. Liquid Freeze Corp.* (1955), 130 Fed. Supp. 471, to pass upon the legal sufficiency of demonstrations of asserted followings of the prior art:

"But care must be exercised in evaluating the effect of these demonstrations. Knowledge after the event is always easy and problems once solved present no difficulties. 'Prior patents "cannot be reconstructed in the light of the invention in suit and then used as part of the prior art."' The prior art must be evaluated by searching to see if the information contained in the patents themselves as distinguished from an after the fact reconstruction, is full and precise enough to enable a person skilled in the art to perform the process or make the machine covered by the patent sought to be anticipated."

The history of this case shows completely and conclusively that appellant's efforts were consumed in an attempt to reconstruct prior patents "in the light of the invention in suit" and to use them "as part of the prior art."

Appellant's position is even less tenable than the defendants' in these cases, because not only did appellant fail to produce a multi-color drip candle following the actual teaching of any prior patent, but in attempting to do so, it proved the unworkability of the patents (Nelson, Fredericks and Funke) even for their purported objects.

### Conclusion.

So completely lacking in any factual or legal respects have been appellant's attempted proofs and arguments, that there can be only one logical conclusion to be drawn from its actions, namely, that appellant deliberately and intentionally misappropriated the invention, in the expectancy of being able, because of its size and resources, to overrun the small manufacturer-appellee.

It is believed that this Court will find good reason in law and equity for affirming the decision of the District Court.

Respectfully submitted,

H. CALVIN WHITE,

*Attorney for Appellee.*